

### **REMARKS**

Claims 10-25 are pending in the present Application. Claim 10 has been amended, claims 1-9, 15, and 23 have been previously cancelled, and claims 26-29 have been withdrawn, leaving claims 10-14, 16-22, and 24-25 for consideration upon entry of the present Amendment.

Support for the amendment to claim 10 can be found at least in claim 6 as originally filed.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

#### **Claim Rejections Under 35 U.S.C. § 102(b)/(e)/§ 103(a)**

Claims 10-14, 16-22, and 24-25 stand rejected under 35 U.S.C. § 102(b)/(e) as being allegedly anticipated by Abe et al. (WO 02/059999/US 7,294,436, hereinafter "Abe") as stated on pages 3-4 of the Office Action dated July 6, 2010. Citations to Abe herein are to the U.S. Patent, U.S. 7,294,436. The Examiner states that Abe teaches all of the elements of claims 10-14, 16-22, and 24-25, including a battery comprising an electrolyte comprising 0.01-10 wt% tert-alkylbenzene and 0.1-1.5 wt% of a biphenyl compound. (Office action dated July 6, 2010, p. 3)

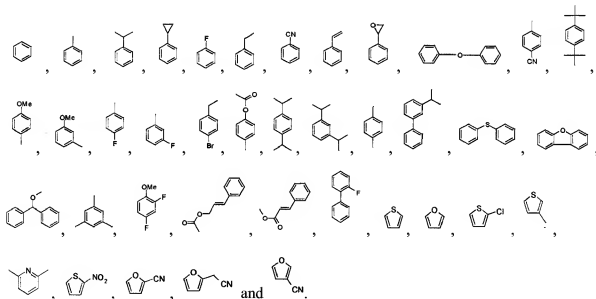
Also, claims 10-14, 16-22, and 24-25 stand rejected under 35 U.S.C. § 102(b)/(e) as anticipated by or, in the alternative, 35 U.S.C. § 103(a) as being allegedly obvious over Abe et al. (WO 02/059999/US 7,294,436, hereinafter "Abe") as stated on pages 4-5 of the Office Action dated July 6, 2010. The Examiner states that Abe teaches all of the elements of claims 10-14, 16-22, and 24-25, including a battery comprising an electrolyte comprising 0.01-10 wt% tert-alkylbenzene and 0.1-1.5 wt% of a biphenyl compound. (Office action dated July 6, 2010, p. 4)

The Applicants respectfully traverse these rejections for at least the following reasons and address them together.

To anticipate a claim, a reference must disclose each and every limitation of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1274 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

For an obviousness rejection to be proper, the Examiner is expected to meet the burden of establishing why the differences between the prior art and that claimed would have been obvious. (MPEP 2141(III)) “A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). To find obviousness, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

Amended claim 10 recites a nonaqueous electrolyte comprising a first additive and a second additive, wherein the first additive is selected from the group consisting of



Abe discloses an electrolyte comprising a tert-alkylbenzene compound and biphenyl. (Abe, col. 3, lines 38-39) Abe states that the tert-alkylbenzene compound preferably has the formula  $(R^1)(R^2)(R^3)C-\phi^1$  in which each of  $R^1$ ,  $R^2$ ,  $R^3$  independently is an alkyl group of 1 to 4 carbon atoms. (Abe, col. 3, line 43)

Abe does not disclose, teach, or suggest a nonaqueous electrolyte wherein the first additive is selected from the claimed group, which does not contain a tert-alkylbenzene. Abe teaches an electrolyte including a tert-alkylbenzene and biphenyl.

Furthermore, the Applicants respectfully assert that the synergistic results disclosed by the Applicants further support the patentability of the instant claims. For example, the Applicants disclose in Examples 6 to 11 the results using the additives isopropylbenzene, vinylbenzene, toluene, mesitylene, thiophene, and furan with biphenyl, ethylbenzene, t-butylbenzene, bromoethylbenzene, cyclohexylbenzene, and fluorobiphenyl, respectively. (Specification, p. 22, Table 4) For at least the reason that Abe does not teach or suggest the first additives isopropylbenzene, vinylbenzene, toluene, mesitylene, thiophene, or furan, one of ordinary skill in the art would not have been prompted to consider adding such compounds to a nonaqueous electrolyte, let alone expect the unexpected and synergistic improvement in overcharge performance disclosed by the Applicants.

Accordingly, for at least these reasons, Abe does not anticipate or render obvious the subject matter of independent claim 10. Claims 11-14, 16-22, and 24-25 depend from claim 10, and thus include the allowable elements of claim 10. Thus the dependent claims are patentable over the cited references for at least the reasons given above for independent claim 10.

Accordingly, reconsideration, withdrawal of the rejection of claims 10-14, 16-22, and 24-25 under 35 U.S.C. § 102(b)/(e), or in the alternative under 35 U.S.C. § 103(a), and allowance of the instant claims are respectfully requested.

**Conclusion**

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection(s) and rejection(s) and allowance of the case are respectfully requested.

Applicants hereby petition for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) or any other necessary fees(s), which may be required for entry and consideration of the present Reply.

If there are any additional charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' Attorneys.

Respectfully submitted,

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